

### REMARKS

In the Office Action mailed February 18, 2009 (hereinafter "Office Action"), Claims 37-41 were rejected under 35 U.S.C. § 101 as allegedly directed to nonstatutory subject matter. Claims 37-41 and 43 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,036,601, issued to Heckel (hereinafter "Heckel"). Claims 26-30, 32-35, and 42 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Heckel, and alternatively rejected as allegedly unpatentable over Heckel in view of U.S. Patent No. 6,196,920, issued to Spaur (hereinafter "Spaur"). Claim 31 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Heckel in view of U.S. Patent Publication No. 2002/0156858, by Hunter (hereinafter "Hunter"), and alternatively rejected as allegedly unpatentable over Heckel in view of Spaur and Hunter. Claim 36 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Heckel in view of Spaur. Applicants respectfully disagree with these rejections, but have nevertheless amended the pending claims to further advance prosecution of the present application.

With this response, Claims 26, 35-37, and 40-43 have been amended. Claims 32 and 38 have been canceled. Claim 44 is new. Accordingly, Claims 26-31, 33-37, and 39-44 are currently pending in the present application. Applicants have carefully considered the issues raised in the Office Action, and respectfully request reconsideration and allowance of the pending claims in view of the remarks set forth below.

#### Claims 37-41 Recite Patent-Eligible Subject Matter

The Office Action rejected Claims 37-41 under 35 U.S.C. § 101 as allegedly directed to nonstatutory subject matter. Applicants respectfully disagree with this rejection, but have nevertheless amended Claim 37 to further advance prosecution.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

Applicants respectfully submit that Claim 37, which recites a computer-based method which comprises actions done "under the control of instructions executed by the ad server," is a method tied to a particular apparatus. Therefore, applicants respectfully submit that Claim 37, along with its dependent Claims 39-41, recite patent eligible subject matter, and respectfully request withdrawal of the 35 U.S.C. § 101 rejections.

Patentability of Claims 26-31, 33-37, and 39-44

Independent Claim 26

The Office Action rejected independent Claim 26 under 35 U.S.C. § 103(a) as allegedly unpatentable over Heckel, and alternatively under 35 U.S.C. § 103(a) as allegedly unpatentable over Heckel in view of Spaur. Applicants respectfully disagree with these rejections, but have nevertheless amended Claim 26 to further advance prosecution of the present application.

As amended, Claim 26 recites:

26. A computer-based method for dynamically incorporating advertisements into a video game defined by gaming code that is executing on a game client system, comprising:

establishing a network connection to a game server;

establishing a network connection to an advertising server separate from the game server; and

while the gaming code is executing and the game is being played:

***receiving over the network connection to the advertising server and storing on the game client system at least one advertisement, each advertisement having a content and at least one advertisement attribute;***

detecting an advertising tag associated with a game object that is presented to a game player, wherein the advertising tag defines criteria for an advertisement to be associated with the game object;

determining, by the game client system, if an advertisement attribute of a stored advertisement matches one or more criteria defined by the detected advertising tag, and if it is determined that an advertisement attribute of a stored advertisement matches one or more criteria defined by the advertising tag, inserting the content of the matching advertisement

into the video game by presenting the content as part of the game object;  
and

*receiving additional data continually over the network connection to the advertising server during a remaining duration of time the gaming code is executing and the game is being played, the additional data including at least one additional advertisement.*  
(Emphasis added for discussion only.)

Applicants respectfully submit that Heckel and Spaur, both alone and in combination, fail to disclose or suggest the combination of features recited in amended Claim 26, including *receiving over the network connection to the advertising server at least one advertisement having a content and at least one advertisement attribute*, and *receiving additional data continually over the network connection to the advertising server during a remaining duration of time the gaming code is executing and the game is being played, the additional data including at least one additional advertisement.*

Heckel fails to disclose or suggest the features recited in Claim 26. For example, Heckel fails to disclose receiving over the network connection to the advertising server an advertisement having a content and at least one advertisement attribute. The Office Action alleges that the "demographic impressions and intended target audience, Column 4, lines 8-9" of Heckel disclose these features. (Office Action, pages 4-5.) Applicants respectfully disagree that these portions of Heckel teach these features. Column 4, lines 1-9 of Heckel describe storing a demographic profile of the user in database on the game server or the ad server. This database is then made available to the ad server, which searches the database to retrieve the demographic data and locate appropriate advertising for the game and user from advertising sources. (Heckel, Col. 4, lines 35-46.) Importantly, there is no disclosure or suggestion in Heckel that this demographic data is ever transferred by the ad server or game server to a game client system as part of an advertisement, as recited in Claim 26.

As discussed previously, applicants also respectfully submit that Heckel fails to disclose or suggest that any transfer from the ad server to the game client system happens *while the gaming code is executing and the game is being played*, as Heckel only discloses such transfers taking place before game play begins or during breaks in game play.

Applicants further submit that Heckel fails to disclose or suggest *receiving additional data continually over the network connection to the advertising server during a remaining duration of time the gaming code is executing and the game is being played, the additional data including at least one additional advertisement*. Heckel merely discloses transferring ad textures upon the establishment of a connection to the ad server (Heckel, Col. 4, lines 59-61), and later periodic transfers of advertising textures and information "[b]etween each level of play, while the game is waiting to synchronize with the game server" (Heckel, Col. 5, lines 16-20). Nothing in Heckel discloses or suggests that additional data is received *continually over the network connection to the advertising server during a remaining duration of time the gaming code is executing and the game is being played*. Instead, Heckel at best discloses periodic transfers of information that begin and end before the end of play, as opposed to *continually during a remaining duration of time* the gaming code is executing and the game is being played, as recited in Claim 26.

Further, applicants respectfully submit that Spaur fails to make up for these deficiencies in Heckel. Spaur, according to its abstract, relates to the playing of games with advertising over a network. The ad server of Spaur sends out advertising information to a new client machine when it is notified of a new player. (Spaur, Col. 10, lines 4-7.) This sending of advertising information comprises a variable advertisement and one or more continuing advertisements, and fits in one packet for most client machines. (Spaur, Col. 10, lines 7-10.) When the ad server updates its ads, it sends packets to each client machine as a notification about the new ads, which causes a load spike. (Spaur, Col. 10, lines 45-50.) Since the ads of Spaur are sent all at once,

and then subsequent ads are sent periodically in a manner that causes load spikes, Spaur fails to disclose or suggest receiving additional data *continually during a remaining duration of time the gaming code is executing and the game is being played*, as recited in amended Claim 26.

Accordingly, applicants respectfully submit that Claim 26 is allowable, and respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claim 26.

Dependent Claims 27-31 and 33-36

Claims 27-31 and 33-36 depend from Claim 26. Applicants respectfully submit that these claims are allowable at least by virtue of their dependency from Claim 26, as well as by virtue of the additional claim features set forth therein.

For example, applicants respectfully submit that the cited patents and publications fail to disclose or suggest the combination of features recited in amended Claim 35, including incrementing a hit count if the time or screen size meet *thresholds that are greater than zero*. The Office Action alleges that Heckel discloses a hit count, but interprets the "threshold" of Heckel as a "threshold of '0'." (Office Action, page 6.) Applicants respectfully submit that nothing in Heckel discloses or suggests a threshold that is *greater than zero*, as recited in amended Claim 35.

As another example, applicants respectfully submit that the cited patents and publications fail to disclose or suggest the combination of features recited in amended Claim 36, including modifying an interactive game behavior of a game object *such that the game object will behave differently upon a subsequent interaction*. The Office Action alleges that moving a card having an advertisement thereon to a different portion of the screen, as disclosed in Spaur, discloses the features of Claim 36. Applicants respectfully disagree, as the position of the card on the screen is not an *interactive game behavior*. Applicants have nevertheless amended the language of Claim 36 to clarify this subject matter, and respectfully submit that Spaur fails to disclose or suggest modifying an interactive game behavior of a game object *such that the game object will*

*behave differently upon a subsequent interaction.* Even if the location of a card on the screen is an "interactive game behavior," nothing in Spaur discloses or suggests that the card will behave any differently upon a subsequent interaction.

Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claims 27-31 and 33-36.

Independent Claim 37

The Office Action rejected independent Claim 37 under 35 U.S.C. § 102(e) as allegedly anticipated by Heckel. Applicants respectfully disagree, but have nevertheless amended Claim 37 to further advance prosecution of the present application.

As amended, Claim 37 recites:

37. A computer-based method for operating an ad server that delivers advertisements to a game client system, each advertisement having a content and at least one advertisement specification, the method comprising:

- under the control of instructions executed by the ad server:
  - establishing a communication link with the game client system that is running a video game;
  - receiving from the game client system a request for an advertisement, the request defining one or more desired criteria;
  - retrieving at least one advertisement having an advertisement specification that matches the one or more desired criteria;
  - transmitting the at least one retrieved advertisement to the game client system over the communication link; and
  - continually transmitting data over the communication link until the game client system stops running the video game.***

(Emphasis added for discussion only.)

Applicants respectfully submit that Heckel fails to disclose each and every feature of amended Claim 37. As discussed above with respect to Claim 26, Heckel at least fails to disclose or suggest ***continually transmitting data over the communication link until the game client system stops running the video game.***

Therefore, applicants respectfully submit that Heckel fails to anticipate Claim 37. Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of Claim 37.

Dependent Claims 39-41

Claims 39-41 depend from Claim 37. Applicants respectfully submit that these claims are allowable at least by virtue of their dependency from Claim 37, as well as by virtue of the additional claim features set forth therein.

For example, as discussed above with respect to Claim 36, applicants respectfully submit that the cited patents and publications fail to disclose or suggest the combination of features recited in amended Claim 41, including incrementing the hit count if the time or screen size meet *thresholds that are greater than zero*.

Accordingly, applicants respectfully request withdrawal of the rejections and allowance of Claims 39-41.

Independent Claim 42

The Office Action rejected Claim 42 under 35 U.S.C. § 103(a) as allegedly unpatentable over Heckel, and alternative as allegedly unpatentable over Heckel in view of Spaur. Applicants respectfully disagree with the rejection, but have nevertheless amended Claim 42 to further advance prosecution of the present application.

As amended, Claim 42 recites:

42. A computer-readable storage medium having stored thereon instructions that, when executed by a processor in a game client system, cause the game client system to execute a method for dynamically incorporating advertisements into a video game defined by gaming code, the method comprising:  
forming a communication link with a game server;  
forming a communication link with an advertising server;  
while the gaming code is executing and the video game is being played:

receiving over the communication link with the advertising server and storing on the game client system at least one advertisement, each advertisement having a content and at least one advertisement specification;

detecting an advertising tag associated with a game object that is presented to a game player, wherein the advertising tag defines criteria for an advertisement to be associated with a game object;

determining if an advertisement specification of one of the received advertisements matches one or more criteria defined by the detected advertising tag, and if it is determined that an advertisement specification of a stored advertisement matches one or more criteria defined by the advertising tag, inserting the content of the matching advertisement into the game by presenting the content as part of the game object; and

***continuing to receive data over the communication link with the advertising server until the gaming code is no longer executing and the video game is no longer being played.*** (Emphasis added for discussion only.)

As discussed above with respect to Claim 26, applicants respectfully submit that the cited patents and publications fail to disclose or suggest the combination of features recited in amended Claim 42, including ***continuing to receive data over the communication link with the advertising server until the gaming code is no longer executing and the video game is no longer being played.***

Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claim 42.

#### Independent Claim 43

The Office Action rejected independent Claim 43 under 35 U.S.C. § 102(e) as allegedly anticipated by Heckel. Applicants respectfully disagree with this rejection, but have nevertheless amended Claim 43 to further advance prosecution of the present application.

As amended, Claim 43 recites:

43. A computer-readable storage medium having stored thereon instructions that, when executed by a processor in an advertising server,

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100



cause the advertising server to execute a method for operating the ad server to deliver advertisements to a game client system, each advertisement having a content and at least one advertisement specification, the method comprising:

establishing a communication link with the game client system that is running a video game;

receiving from the game client system a request for an advertisement, the request defining one or more desired criteria;

retrieving at least one advertisement having an advertisement specification that matches the one or more of the desired criteria; and

***continually transmitting data over the communication link until the game client system stops running the video game, the data including the at least one retrieved advertisement.*** (Emphasis added for discussion only.)

As discussed above with respect to Claim 26, applicants respectfully submit that Heckel fails to disclose each and every feature of amended Claim 43, including ***continually transmitting data over the communication link until the game client system stops running the video game, the data including the at least one retrieved advertisement.***

Therefore, applicants respectfully submit that Heckel fails to anticipate Claim 43. Accordingly, applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of Claim 43.

#### New Claim 44

New Claim 44 depends from Claim 26. Applicants respectfully submit that this claim is allowable at least by virtue of its dependency from Claim 26, as well as by virtue of the additional claim features set forth therein.

For example, as discussed above, applicants respectfully submit that none of the cited patents and publications disclose or suggest receiving additional data continually over the network connection to the advertising server. It therefore follows that none of the cited patents and publications could disclose or suggest that such receiving additional data continually over

the network connection to the advertising server includes *receiving packets filled with nonvaluable data to maintain the continual receipt of additional data*, as recited in Claim 44.

Accordingly, applicants respectfully request allowance of Claim 44.

CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully submit that Claims 26-31, 33-37, and 39-44 are in condition for allowance over the patents and publications of record, and respectfully request reconsideration and allowance of the same. The Examiner is invited to contact the undersigned attorney at the number provided below to resolve any issues that may arise in order to advance prosecution of this application.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



David P. Sheldon  
Registration No. 62,494  
Direct Dial No. 206.695.1611

RCT/DPS:lal

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100